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In re Application of :
YAMASAKI et al. : DECISION ON
Application No.: 09/647,772 : PAPERS UNDER 37 CFR 1.42
PCT No.: PCT/JP99/01798 :
Int. Filing Date: 04 April 1999 :
Priority Date: 05 April 1998 :
Attorney Docket No.: 06501-065001 :
For: INDOLE DERIVATIVES

This decision is in response to applicants' "Renewed Submission Under 37 CFR 1.42" filed 11 February 2002. In a decision dated 27 July 2001, applicants' petition filed 04 April 2001 was dismissed because the declaration was not acceptable under 37 CFR 1.42 and 37 CFR 1.497.

BACKGROUND

On 04 April 1999, applicants filed international application PCT/JP99/01798, which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 October 1999. On 20 October 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 05 October 2000.

On 04 October 2000, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, *inter alia*, by: the basic national fee and the international application.

On 06 November 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e).

On 04 April 2001, applicant filed the surcharge under 37 CFR 1.492(e) and a declaration and power of attorney executed by Noritsugu Yamasaki; Takafumi Imoto; Hiroshi Kayakiri; Osamu Onomura; Takahiro Hiramura as inventors and Noriko Oku, Chikado Oku, and Tomohito Oku on behalf of deceased inventor, Teruo Oku. In a decision dated 27 July 2001, applicants request under 37 CFR 1.42 was refused.

On 11 February 2002, applicant filed the present petition and a one-month extension of time.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 11 February 2002 was executed by Noriko Oku, Chikado Oku, and Tomohito Oku as "representatives" of deceased inventor, Teruo Oku. However, the declaration does not state that Noriko Oku, Chikado Oku, and Tomohito Oku are the "legal" representatives or are all of the heirs of the deceased inventor. Accordingly, the declaration fails to identify the proper relationship under 37 CFR 1.497(b)(2).

Moreover, a review of the declarations filed on 04 April 2001 reveals that the declaration is not in an acceptable form. Specifically, there is an issue as to whether the declaration has been properly executed. The declaration submitted includes two sheets numbered 2. It is unclear if the inventors were presented with only page 2, in which case the execution would be improper, or they if were presented with a complete declaration for signing, but counsel subsequently compiled the declaration into the single document filed 04 April 2001, which is improper. (See MPEP 201.03) In this regard, the new declaration submitted with the present petition overcomes the above discussed defect, however, it has not been executed by all of the inventors. Therefore, the declaration is still unacceptable.

CONCLUSION

For the above reasons, the renewed request for status under 37 CFR 1.42 is **REFUSED**.

Because the response filed, 11 February 2002, appears to be a bona fide response to the Decision mailed 27 July 2001, Applicant is hereby given **TWO MONTHS** from the mail date of this Decision to file the proper response. The proper response must include an acceptable declaration under 37 CFR 1.497 which has been executed by inventors and either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor. Failure to respond will result in the abandonment of the application. No extension of this time limit will be granted under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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